



Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler et al

Serial No.: 09/810,920

Filing Date: March 16, 2001

Title: Polymeric Thickeners for Oil-containing Compositions

Assistant Commissioner for Patents  
Washington, DC 20231

Group Art Unit: 1714

Examiner: Peter Szekely

#21  
RECEIVED  
JUN 26 2003  
TC 1700

PETITION

Sir,

This Petition is being filed contemporaneously with a very similar petition on the closely related parent application Serial No. 09/398,377. It is believed that the Commissioner will find it convenient to consider both petitions at the same time.

This is a petition asking the Commissioner to direct the Examiner as to the correct construction of certain claims. The Examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims.

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**CERTIFICATE OF MAILING UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231  
On June 17, 2003

Typed name of person signing this certificate: T. H. P. Richardson  
Signature

## The Claims

The invention relates to the use of certain side chain crystalline (SCC) polymers as thickening agents for oil-containing compositions. The claims in question are independent claims 1 and 20, which are set out below (with emphasis added). Claim 1 is a composition Claim requiring that the thickening agent is present "in amount such that it thickens the oil". Claim 20 is a method Claim requiring that the amount of the thickening agent is "such that, after step (ii) [the second step of the method], it thickens the oil". The Examiner is examining these claims on the basis that they are limited to compositions containing 0.1 to 12% by weight of the SCC polymer thickening agent.

The application includes claims which are dependent on independent claims 1 and 20 and which have also been rejected. The application also includes other independent claims, and claims dependent thereon, which have been allowed and as to which there is no dispute.

1. A thickened oil cosmetic composition which comprises
    - (1) an oil, and
    - (2) uniformly dispersed in the oil as a crystallized solid, a side chain crystalline (SCC) polymer which has a crystalline melting point  $T_p$  and which
      - (a) is substantially free of fluorine atoms, carboxylic acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups; and
      - (b) **is present in amount such that it thickens the oil;**
- the composition being at a temperature
- (i) which is below  $T_p$ , and
  - (ii) at which the composition, in the absence of the polymer, is liquid.

20. A method of making a thickened oil cosmetic composition comprising an oil and, dispersed in the oil, a side chain crystalline (SCC) polymer which

(a) has a crystalline melting point,  $T_p$ , and an onset of melting temperature,  $T_o$ , such that  $T_p - T_o$  is less than  $T_p^{0.7}$ , and

(b) is substantially free of fluorine atoms, carboxylic acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups;

the method comprising

(i) dissolving the SCC polymer in the oil at a temperature above  $T_p$ , and

(ii) cooling the solution to crystallize the polymer in the oil;

**the amount of the SCC polymer being such that, after step (ii), it thickens the oil,** and the temperature at the end of step (ii) being a temperature which is below  $T_p$ , and at which the composition, in the absence of the polymer, is liquid.

### **The Issue**

The issue is the meaning of the phrase "is present in amount such that it thickens the oil" in Claim 1, and the meaning of phrase "the amount of the SCC polymer being such that, after step (ii), it thickens the oil" in Claim 20.

### **The Relevant Facts**

1. The Disclosure of the Specification as filed.

The specification as filed does not state explicitly that the thickening agent "is present in amount such that it thickens the oil". It does, however, contain numerous statements and specific Examples which make it clear that the purpose and result of adding the crystalline polymer thickening agent is to thicken the oil. The following passages are quoted by way of example.

*Polymeric Thickeners for Oil-Containing Compositions (title)*

*We have discovered, in accordance with the present invention, that a broad range of side chain crystalline (SCC) polymers can be used to thicken oils..... (Page 2, lines 1-8)*

*A thickened oil composition (page 3, lines 9 and 22, and line 1 of claims 1, 9, 15 and 20)*

*using these SCC polymers as thickening agents (page 4, line 14),*

*the SCC polymers used as thickeners in the present invention (page 6, line 14), when the SCC polymer is used to thicken an oil or mixture of oils which is free of water... (page 8, lines 27-28)*

*the thickening polymer (page 9, lines 30, page 10, lines 2 and 4)*

*the polymeric thickener (page 5, line 29, page 6, line 12, and page 10, lines 14 and 22 ),*

*The amount of the polymeric thickener preferably used varies with the application. It is usually unnecessary for the amount of the thickener to be more than 10% by weight based on the weight of the oil. Smaller amounts such as 2 to 7% based on the weight of the oil in compositions which are free of water, and 0.5 to 5% based on the weight of composition in water-in-oil emulsions, are often effective. (Page 10, lines 14-18)*

*A thickened oil composition (claims 1,9, 15, and 20)*

2. After the claims had been rejected under 35 U.S.C. 102 and 103 over U.S. Patent No. 5,281,329 ("Mueller"), Applicant amended the claims to require that the thickening agent "is present in amount such that it thickens the oil", and argued that this limitation distinguished the claims from the Mueller reference.

3. The Examiner rejected the amended claims under 35 U.S.C. 112 for lack of written description on the ground that the added limitation involved new subject matter, and for lack of enablement.

4. Applicant traversed the rejection under 35 U.S.C. 112, arguing that no new subject matter was involved and that the claims were enabled, referring to the passages in the specification quoted above, noting that the specification provides specific examples of thickened oils, and referring to the disclosure in Morawsky U.S. Patent No. 5,736,125.

5. The Office Action mailed November 21, 2002, repeated the rejection under 35 U.S.C. 112.

6. In an Office Action mailed November 25, 2002, on the parent application Serial Numbers 09/398,377, on which the same issue had arisen, the Examiner withdrew his rejections, and stated:

*The Examiner acknowledges that Morawsky... incorporated by reference, does contain the phrase "present in the amount sufficient to thicken the composition" in column 3, lines 19-24, so that limitation is not new matter. Since (Morawsky) defines that amount as 0.1-12% by weight, the phrase will be interpreted as such.*

7. The Reply mailed January 27, 2002, repeated and amplified Applicants' argument that there was no new subject matter, referring to a declaration by Mr. Steinberg, and to the Morawsky Patent and four additional U.S. Patents containing claims in which the expressions "thickening amount", "thickening effect amount" and "effective thickening amount" were employed.

8. The Office Action mailed March 31, 2003, withdrew the rejection under 35 U.S.C. 112. The section entitled Response to Arguments in the Office Action includes a statement that "Morawsky... shows that the concentration range at which an SCC polymer thickens oil is from about 0.1% to about 12%". The Office Action does not state that the Examiner is examining the claims on the basis that they are limited to 0.1 to 12% of the thickening agent.

9. In a telephone interview with the undersigned on June 12, 2003, the Examiner made statements which, insofar as they could be understood by the undersigned, indicated that the Examiner was examining the claims on the basis that they are limited to 0.1 to 12% of the thickening agent.

10. The disclosure of Morawsky U.S. Patent No. 5, 736,125.

Morawsky, which is referred to on page 1, lines 19-20 of the specification as filed, and which is now specifically incorporated by reference, discloses that certain specifically defined carboxyl-containing SCC polymers can be used to thicken oils. The following passages are quoted from Morawsky.

*In the compositions, the amount of thickening copolymer, as defined above, is present in an amount sufficient to thicken the composition to the desired thickness. In general it is present in an amount of from about 0.1% to about 12%, particularly from about 0.5 to about 10% by weight of the oil.... The composition may be thickened to the desired viscosity which is dependent on the functional properties of composition. (Column 3, lines 19-33).*

*1. A composition comprising an oil and a polymeric thickener consisting essentially of at least one copolymer which has a hydrophobic functionality sufficient to provide at least partial solubility in oil and a hydrophobic functionality present in an amount effective to provide thickening of the oil, said hydrophobic functionality being... (Claim 1).*

*6. The composition of Claim 1, wherein the copolymer is present in an amount ranging from about 0.1 to about 12% by weight of the oil. (Claim 6).*

11. In the Reply mailed contemporaneously with this Petition, Applicant asked the Examiner once again to consider the proper construction of the claims, and either

(i) to state on the record his agreement that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, or

- (ii) to send this Petition to the Petitions Branch so that the issue could be resolved.

12. The reply mailed contemporaneously with this Petition also requests addition of the following claims 62 and 63 which are dependent on claims 1 and 20 and which specify that the thickening agent is present in amount 0.1 to 12% by weight. The specification as filed does not state explicitly that the thickening agent can be present in amount 0.1 to 12%. The basis for these claims is in Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference. Applicant's purpose in adding these claims is to provide further evidence, through the doctrine of claim differentiation, that claims 1 and 20 cover amounts of the SCC polymer outside the range of 0.1 to 12%.

### **Argument**

For the reasons set out below, Applicant believes that the claims 1 and 20 should not be examined on the basis of the limited construction adopted by the Examiner, but rather on the basis that the claims cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%.

A. The passages quoted in paragraph 1 above from the specification as filed make it clear that Applicant's invention is directed broadly to the use of the defined SCC polymers as thickening agents for oil-containing compositions, and is not limited to any specific numerical range of concentration. The disclosure of the specification itself is reinforced by the facts and arguments set out in the Reply mailed in January 27, 2002, to which reference can be made.

B. The passages quoted in paragraph 6 above from Morawsky make it clear that Morawsky's invention is directed broadly to the use of the defined carboxyl-containing SCC polymers as thickening agents for oil-containing compositions, and is not limited to the use of 0.1 to 12% of the SCC polymer. The quoted passage from column 3, lines

19-33, states simply that the SCC polymer is used "in an amount sufficient to thicken the composition, and then goes on to state that "in general" (i.e. **not** invariably) the amount is from "about 0.1% to about 12%". Claim 1 similarly refers to "an amount effective to provide thickening of the oil", and the presence of Claim 6, specifying that the amount is 0.1 to 12% (and not otherwise limiting Claim 1), puts it beyond doubt (having regard to the requirement of 35 U.S.C. 112, fourth paragraph, that a dependent claim must "specify a further limitation of the subject matter claimed) that the amount referred to in Claim 1 is not limited to the range of 0.1 to 12%.

C. The presence of amended claims 62 and 63 makes it clear (again having regard to 35 U.S.C. 112, fourth paragraph) that claims 1 and 20 are not limited to the range of 0.1 to 12%.

D. MPEP 2111 requires that during Patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification".

Respectfully submitted,



T. H. P. Richardson,

Registration No.28,805,

Tel No. 650 854 630





Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
JUN 26 2003  
TC 1700

Applicant: Bitler et al

Group Art Unit: 1714

Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

Title: Polymeric Thickeners for Oil-containing Compositions

Assistant Commissioner for Patents

**Attention Petitions Branch**

Washington, DC 20231

**Request for Decision on previously-filed Petition, and for Corrected Filing Receipt**

Sir,

Attached is a copy of a Petition mailed Oct. 25, 2001, requesting a Corrected Filing Receipt, together copies of the transmittal letter and the Declaration and Power of Attorney referred to therein, and a copy of page 1 of the specification filed with the application, stating the priorities claimed. These papers were received by the Office, but Applicants have received no answer to them.

On page 21 of the Reply mailed February 28, 2002, a copy of which is attached, Applicants noted that the Petition was incorrect in stating that the priority claim to the PCT application was "made after the filing date and subsequent publication of the application on August 30, 2001". As shown by the attached page 1 of the specification as filed, the application as filed did expressly and correctly set out the priorities claimed. Therefore, the Petition should more correctly have stated that the Declaration filed with

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On June 17, 2003

Typed name of person signing this certificate: T. H. P. Richardson  
Signature



the application mistakenly omitted reference to the priorities explicitly set out in specification, and that a revised Declaration was being filed in order to correct that mistake. Applicants asked that the Examiner, or other person responsible for responding to the Petition, should contact the undersigned if further information or action was needed in order to confirm that both priorities had been properly claimed.

The Examiner did not respond to that request. Therefore, on page 27 of the Reply mailed June 22, 2002, copy attached, Applicants requested the Examiner to review the discussion of the Petition in the previous Reply and to confirm that both priorities had been properly claimed.

The Examiner did not respond to that request. Therefore, on page 30 of the Reply mailed September 27, 2002, copy attached, Applicants repeated the request to the Examiner to review the discussion of the petition in the previous Replies and to confirm that both priorities had been properly claimed.

On page 5 of the Office Action mailed March 31, 2003, the Examiner stated:  
*As far as the Petition is concerned, the Examiner does not handle petitions and all inquiries about petitions should be addressed to the Petition Branch.*

Applicants renew their request for a decision on the Petition, and for a Corrected Filing Receipt.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. H. P. Richardson', with a stylized flourish at the end.

T. H. P. Richardson,

Registration No.28,805,

Tel No. 650 854 630

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Steven P. Bitler, et. al.

Serial No.: 09/810,920

Filing Date: March 16, 2001

For: POLYMERIC THICKENERS FOR OIL-  
CONTAINING COMPOSITIONS

Group Art Unit: 1713

Examiner: N/A

Pasadena, California

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Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: Petitions Examiner Office of the Deputy Assistant Commissioner for Patents

**PETITION TO ADD ADDITIONAL PRIORITY CLAIM UNDER 37 C.F.R. § 1.55**

Dear Sir:

1. Applicant petitions for entry of the following accompanying papers with respect to the priority claim in this case being made after the filing date and subsequent publication of the application on August 30, 2001:  
  
\* Declaration and Power of Attorney for Patent Application
2. Applicant respectfully requests that a corrected filing receipt be issued which cites both priority claims of U.S. Application No. 09/398,377 and PCT Patent Application No. PCT/US00/40780 or an explicit written acknowledgment that this priority has been claimed.
3. A check in the amount of \$130.00 in payment of the petition fee (37 C.F.R. § 1.17(i) is enclosed herewith. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, if such fees are due, or credit any overpayment to Deposit Account No. 19-2090.
4. A duplicate of this paper is attached.

Respectfully submitted,

SHELDON & MAK

By: 

Jeffrey G. Sheldon, Reg. No. 27,953

Date

10/25/2001  
225 South Lake Avenue, Suite 900  
Pasadena, California 91101  
(626) 796-4000

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Deborah Grafe

Claim 45      which requires that the SCC polymer contains units derived from  
hydroxyethyl acrylate

PETITION

*Cery filed  
6/17/2003*

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On October 25, 2001, Applicant mailed a paper entitled Petition to Add  
Additional Priority Claim under 37 CFR 1.55, together with a Declaration and Power of  
Attorney setting out the two priorities claimed for this application, namely priority under  
35 U.S.C. 120 from U.S. Serial No. 09/398,377, filed Sept. 17, 1999, and priority under  
10 35 U.S.C. 119 from International Application No. PCT/U.S. 00/40780, filed August 30,  
2000. The specification originally filed with this application correctly states, on page 1,  
lines 5-9, that those two priorities are claimed. However, the Declaration filed with the  
application did not referred to either of these priorities, and the transmittal letter referred  
only to the U.S. priority. The Office issued a Filing Receipt listing the U.S. priority only.  
15 The Petition and the revised Declaration were filed in order to claim the priority of the  
PCT application under 35 U.S.C. 119.

Reviewing the Petition, it has been noted that it incorrectly states that the priority  
claim (to the PCT application under 35 U.S.C. 119) was "made after the filing date and  
20 subsequent publication of the application on August 30, 2001". Since the application did  
expressly and correctly set out (on page 1 of the specification) the priorities that were  
claimed, the Petition should more correctly have stated that the Declaration filed with  
the application mistakenly omitted reference to the priorities explicitly set out in the  
specification, and that a revised Declaration was being filed in order to correct that  
25 mistake.

If the Examiner (or other person responsible for responding to the Petition)  
requires further information or action in order to confirm that both priorities have now  
been properly claimed, please contact the undersigned by telephone.

Cery M-4  
6/17/2003

(1) Mueller nowhere discloses a composition in which the presence of the SCC polymer results in thickening of the oil; and

(1) Mueller's sole objective is to provide compositions in which the presence of the SCC polymer increases the pourability of the oil,

5 and it cannot be obvious to modify Mueller in a way that is directly contrary to Mueller's instructions, i.e. so as to **decrease** the pourability of the oil, as taught by Applicants, rather than to **increase** the pourability of the oil, as taught by Mueller.

#### PREVIOUSLY-FILED PETITION TO ADD ADDITIONAL PRIORITY CLAIM

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The end of the previous Reply contains a discussion of the previously-filed Petition to Add Additional Priority Claim, on which no decision has been received by Applicants. The Examiner is asked to review that discussion and the Petition, and to confirm that both priorities have now been properly claimed.

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#### CONCLUSION

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It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

25

Respectfully submitted,

T. H. P. Richardson, Registration No.28,805,  
Tel No. 650 854 630

Copy filed  
6/7/2003

As previously noted, it appears to Applicants that the Examiner's rejection of claims 1-5, 9-12, and 20 under 35 U.S.C. 102 and 35 U.S.C. 103 are based on a construction of the claims that ignores the limitation that the SCC polymer is present in amount such that it thickens the oil. Applicants submit that, since the claims in question

5 do in fact contain that limitation, their patentability under 35 U.S.C. 102 and 103 must be determined on the basis that the limitation is indeed present, independently of any questions that may arise under 35 U.S.C. 112. In summary, Applicants submit that the rejection of these claims under 35 U.S.C. 102 and 103 should be withdrawn, because

10 (1) Mueller nowhere discloses a composition in which the presence of the SCC polymer results in thickening of the oil;

(2) Mueller's sole objective is to provide compositions in which the presence of the SCC polymer increases the pourability of the oil, i.e. makes the oil thinner; and

15 (3) Mueller is concerned only with oils which are clearly different from those specified in Claim 32;

and because it cannot be obvious to modify Mueller in a way that is directly contrary to Mueller's instructions, i.e. so as to **decrease** the pourability of the oil, as taught by Applicants, rather than to **increase** the pourability of the oil, as taught by Mueller.

20 **RENEWED REQUEST FOR CONSIDERATION OF PREVIOUSLY-FILED PETITION  
TO ADD ADDITIONAL PRIORITY CLAIM**

The end of the Reply to Paper #4 contains a discussion of the earlier-filed Petition to Add Additional Priority Claim, on which no decision has been received by

25 Applicants. The Examiner is asked to review that discussion and the Petition, and to confirm that both priorities have now been properly claimed.

**CONCLUSION**

30 It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding